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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,976	05/16/2005	Soichiro Watanabe	272239US0PCT	1724
22850 7590 11/25/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MERCIER, MELISSA S				
ART UNIT 1615		PAPER NUMBER		
NOTIFICATION DATE 11/25/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/534,976

Applicant(s)

WATANABE, SOICHIRO

Examiner

MELISSA S. MERCIER

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-8,10-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Summary

Receipt of Applicants Remarks filed on July 21, 2009 is acknowledged. No claim amendments were submitted. The claims filed on January 21, 2009 are the current claims of record. Claims 1-3, 5-8, 10-14, and 16-20 remain pending in this application.

Maintained Rejections

Claim Rejections - 35 USC § 103

Claims 1, 5, 11-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,169,114) in view of Shiraishi et al. (US Patent 5,733,344), Sugii et al. (US 2003/0044599), and Dahms et al. (US Patent 5,674,475).

Yamaguchi discloses a peel off type pack comprising 13.0% polyvinyl alcohol and about 70% water (Example 23).

Yamaguchi does not disclose a titanium-titanium dioxide sinter as a colorant, a water soluble thickener, and a polyglycerol fatty acid ester.

Shiraishi discloses a temporary hair dye containing titanium black and other pigments (abstract). Titanium-titanium dioxide sintered substance is disclosed as titanium black (column 2, lines 9-10). Regarding the specific conditions of preparation of the sinter, it is the examiners position that Shiraishi discloses the use of Tilack D, which applicant's specification on page 6, top paragraph, recites as an acceptable sinter, so it would therefore meet the specific limitations of the instant claims.

Regarding the specific limitations of claims 12-14 and 16, the claim is drawn to a process of preparing the titanium-titanium dioxide sinter, thereby considered a product by process limitation, since the claims are drawn to the product, the method by which the product is obtained does not hold patentable weight. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have optimized the particle size of the dye in order to optimize the coloring and to negate any kind of gritty feeling commonly associated with larger particles.

It is additionally acknowledged that Shiraishi is drawn to a hair dye formulation and not a pack, however, it is noted by the examiner that the instant application discloses the use of titanium-titanium dioxide sinter is "to increase the covering effect of the cosmetic pack preparation, to make it easy to identify the applied areas and peeled areas and the cleaning effect, to increase the drying speed and film strength, thereby rendering the film easy to be peeled off". (page 5, 2nd paragraph). Additionally, it is noted Applicant states "any titanium-titanium dioxide sinter commonly used in cosmetic composition can be used without specific limitations". Therefore, it would have been obvious to a person of ordinary skill in the art to have incorporated the titanium-titanium dioxide sinter of Shiraishi in order to obtain a cosmetic composition with a dark coloring and that has a weak pigment base and therefore, will not stain the skin (column 1, lines 43-54).

Sugii discloses facial pack materials, such as peel off packs, comprising a filler, which provides a wet pressure sensitive adhesive composition which exhibits tackiness in the presence of water or a hydrophilic medium, adheres well to the application site,

dries speedily, has high mechanical strength after drying and can be peeled off easily (abstract). Suitable fillers include silica and clay (paragraph 0037).

Dahms discloses emulsified composition based on polyglycerol fatty acid esters (abstract). With the addition of a polyglycerol fatty acid ester to a composition, the composition becomes stable against temperature and highly water proof and the emulsion property is little affected by pH (column 1, lines 5-10). As for the polyglycerol fatty acid esters, the following esters are enumerated; tetraglyceryl (di, tri, or tetra)-laurate, -myristate, -palmitate, -stearate, or -behenate, hexaglyceryl (di, tri, tetra, or penta) -laurate, -myristate, -palmitate, -stearate, or behenate; decaglycerol (tri, tetra, penta, hepta, or octa) -laurate, -myristate, -palmitate, -stearate or -behenate etc (column 3, lines 33-38). The emulsifier can be present in the amount of 1-4% by weight (column 2, lines 51-55).

It would have been obvious to one of ordinary skill in the art to have incorporated the titanium-titanium dioxide sinter of Shiraishi, as a colorant; a water soluble thickener of Sugii; and a polyglycerol fatty acid ester of Dahms, into the peel off face pack composition of Yamaguchi, to each be employed for the beneficial properties are outlined above. All components are suitable for cosmetic applications, therefore, one of ordinary skill in the art would expect to form another suitable cosmetic composition utilizing each components separate functional properties.

Claims 2-3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,169,114) in view of Shiraishi et al. (US Patent

5,733,344), Sugii et al. (US 2003/0044599), and Dahms et al. (US Patent 5,674,475), as they apply to claim 1, and further in view of Kern et al. (US Patent 4,717,737).

The combined teachings of Yamaguchi, Shiraishi, Sugii, and Dahms are discussed above.

They do not disclose the use of dioctyl sodium sulfosuccinate.

Kern discloses an antibacterial composition in the form of a lotion, cream, and ointment, for example (column 1, lines 5-13). The composition comprises dioctyl sodium sulfosuccinate, as an antibacterial agent.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have used the antibacterial agent dioctyl sodium sulfosuccinate in the composition of Minnix and Shiraishi. Since Yano discloses the use of antibacterial agents in his peel-off type cosmetic pack. It would have been within the knowledge of one of ordinary skill in the art at the time the invention was made to have incorporated the particular antibacterial component for its functional properties.

Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al. (US Patent 6,169,114) in view of Shiraishi et al. (US Patent 5,733,344), Sugii et al. (US 2003/0044599), and Dahms et al. (US Patent 5,674,475), as they apply to claim 1, and further in view of Kanada et al. (US Patent 6,596,285).

The combined teachings of Yamaguchi, Shiraishi, Sugii, and Dahms are discussed above.

They do not disclose the use of 2 different PVA's or ascorbic acid or glycyrrhizin acid derivatives.

Kaneda discloses polyvinyl alcohols are divided into several grades based on differences in the degree of polymerization and the degree of saponification. The degree of polymerization is usually indicated by the viscosity measurement of a 4%-concentration aqueous solution at 20C. For the present invention, those with a low viscosity of 4 cps to a high viscosity of 70 cps can be used. However, the formed film tends to become stronger and the viscosity of the pack increases as the degree of polymerization becomes higher. Therefore, considering the adequate strength of the film and the viscosity which makes pack application easy. On the other hand, the degree of saponification is defined based on different specification ratios of the acetyl groups in polyvinyl acetate when manufacturing polyvinyl alcohols, which is largely divided into the complete saponification type which is saponified almost completely (98-100%), and "the partial saponification type", which is partially saponified (87-89%) with some remaining acetyl groups. Although both saponification types can be used, the partial saponification type has a higher solubility at room temperature, better viscosity stability at lower temperatures, and a superior ability to emulsify the blended oil, and therefore it is preferable to use the partial saponification type polyvinyl alcohol. The blend ratio of the aforementioned polyvinyl alcohol is preferably 5-20 wt %, more preferably 9-15 wt %, of the total amount of the pack cosmetic. If the blend ratio is less than 5 wt %, then a film with adequate strength will not form and even peeling will be

difficult. On the other hand, if the blend ratio is more than 20 wt %, then the viscosity will be too high and application may not be easy (column 2, lines 20-52).

Kanada additionally disclose the use of antioxidants (column 4, line 37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used two different forms of PVA as taught by Kaneda in order to optimize the physical characteristics of strength and viscosity in order to make application of the product easier. Ascorbic acid is a well-known antioxidant used in cosmetic compositions.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. Applicant argues:

***Shiraishi should not be combined with Yamaguchi or any other reference because it relates to a temporary hair dye and not a peel off type pack or similar composition to be applied to the skin (i.e. it relates to a different field of endeavor).**

In response to applicant's argument that Shiraishi is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Shiraishi discloses the sinter is used to obtain a cosmetic composition with a dark

coloring and that has a weak pigment base and therefore, will not stain the skin (column 1, lines 43-54). It would have been obvious skilled artisan to incorporate a dye with such properties into a facial composition since one would not want to stain the skin of the face for aesthetic purposes.

***the sinter addresses the problem of reduced color pigment dispersability.**

In response to applicant's argument that the prior art does not address the issue of dispersability, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is (571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615